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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/03/2003

31

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/277,226

Applicant(s)

BARA ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-60 and 62-67 is/are pending in the application.
- 4a) Of the above claim(s) 20-22, 24, 30-39, 41, 58 and 67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-19, 23, 25-29, 40, 42-57, 59, 60 and 62-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1, 3-60 and 62-67 are pending. Claims 20-22, 24, 30-39, 41, 58, 61 and 67 are withdrawn from consideration, as they are directed toward non-elected subject matter.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/16/03, Paper No. 30, has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, 63, 23, 44, 60, and 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase "pigments coated with at least one silicone compound chosen from polydimethylsiloxanes, and pigments coated with polymers" in claim 16 (last three lines) is vague and indefinite, as it is confusing. Are not polydimethylsiloxanes, polymers? Is Applicant claiming a range within a range?

(ii) Claim 63 is vague and indefinite, as it is confusing. Are not foundations, blushers, eyeshadows, eyeliners, mascaras, and lipsticks, make-ups? Is Applicant claiming a range within a range?

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(iii) The term "functionalized" in claim 23 (line 2) is vague and indefinite, as it is confusing. What does functionalized mean? The specification does not define this term and one of ordinary skill in the art would not be apprised of its meaning.

(iv) Claims 44 and 60 are vague and indefinite, as they are confusing. How are adjuvants and active principles different from additives? The specification does not explain the difference between these terms, and one of ordinary skill in the art would not be apprised of their different meanings.

(v) The term "thickened" in claim 64 (line 2) is a relative term which renders the claim indefinite. The term "thickened" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-19, 23, 25-29, 40, 42-57, 59-60 and 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 373 661 (661) in view of 6,074,633.

The instant invention is directed toward a water-in-oil emulsion comprising a silicone oil, a dyestuff, and an alpha, omega-substituted oxyalkylenated silicone, wherein the emulsion has a dynamic viscosity of 100mPa.s-20Pa.s, and is directed toward a method for reducing the transfer/migration of a composition by introducing into a composition, an emulsion comprising

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an alpha, omega-substituted oxyalkylenated silicone in an amount effective to reduce transfer/migration, wherein the composition does not comprise clay.

EP '661 is directed to water-in-oil emulsion cosmetics that contain an emulsifier mixture, an oily base containing a silicone oil and water. The emulsions have a viscosity of 20,000 cps or below at 25 C, which is equivalent to 200 poise or less. See the abstract. Applicant discloses at page 21, 1st paragraph that a dynamic viscosity of 100mPa.s to 20Pa.s is equivalent to 100 cps to 200 poise, which range is encompassed by EP '661. Milky lotions, body-care lotions, and liquid foundations are also taught in the abstract.

For oxyalkylenated silicone emulsifiers as part of the emulsifier mixture, see page 3, lines 23-38. For pigments and fillers of instant claims 16, 17 and 50, see page 6, lines 49-55. The total amount of powders including fillers and pigments is from 10-40 wt.%. For a mixture of 5.0 wt.% titanium dioxide, 0.4% red oxide, 0.7% yellow iron oxide and 0.1% black iron oxide pigments with 3.0% talc, see the powder component of example 5 at page 15. For cyclic siloxanes such as cyclotetrasiloxane (n-4) and cyclopentasiloxane (n-5), see page 3, lines 4-6 and examples 2-4 at pages 11-13. EP '661 discloses that the silicone oil can be used in any weight percent and that the amount of oily base, which may be only silicone oil, is from 25-45 wt.% (page 3, lines 8-14).

For about 67 wt.% of an aqueous phase containing 5.0% of a C2-6 alcohol (ethanol), 2.0% of a polyol (glycerol), and 0.6 of other adjuvants and active principles and about 33 wt.% of a fatty phase, see example 2. Co-surfactants are disclosed at page 3, line 15 to page 6, line 31.

Since the compositions of EP '661 contain the same amount of filler and silicone oil as instantly claimed they would be expected to have the same weight ratio of filler to silicone oil.

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Additionally, since EP '661 discloses the same fillers and silicone oils as instantly claimed, it would be expected to meet the formula of instant claims 56 and 57.

EP '661 does not disclose an alpha, omega-substituted oxyalkylenated silicone.

US '633 is directed to cosmetic compositions such as shampoos that contain at least one oxyalkylenated silicone (title and abstract). US '633 teaches that alpha, omega-substituted oxyalkylenated silicone can be used in place of and for the same purpose as oxyalkylenated silicones wherein the oxyalkylene chains are pendant. See page 4, lines 36-55. The preferred oxyalkylenated silicones of US '633 are those of formulas (I) and (II). See page 5, line 50 to page 6, line 5. In formula (I), when R1 is methyl (page 5, line 55) and R2 is $\text{C}_6\text{H}_5\text{C}-\text{O}-$ $(\text{C}_2\text{H}_4\text{O})_a(\text{C}_3\text{H}_6\text{O})_b-\text{R}_5$ (page 5, line 25), wherein R5 is methyl (page 5, line 56), c is 0-4, a is 0-50, n is 0-500 and m and o are O (page 5, lines 39-46), it encompasses the instantly claimed alpha, omega-substituted oxyalkylenated silicone of claims 3-9. US '633 discloses that the compositions containing the oxyalkylenated silicones have a viscosity greater than 200 mPa.s (page 6, line 11).

Neither of the references teaches the average molecular weight of R (claims 5 and 9), the weight ratio of oxyethylene groups to oxypropylene groups (claims 6, 7 and 9), the average particle size of the filler (claim 53) or the shape of the filler (claim 54). A silicone meeting the limitations of instant claims 3 and 9 as described above would be expected to exhibit these characteristics. It is within the skill in the art to select optimal parameters of a composition in order to achieve a beneficial effect. One of ordinary skill in the art would have been motivated to select an optimal particle size and shape of the filler powders for aesthetic purposes. Furthermore, a change in size is generally recognized as being within the level of ordinary skill

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in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Therefore, absent evidence of unexpected results, the particle size and shape of the filler is not considered critical to the invention.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the alpha, omega-substituted oxyalkylenated silicone of US '633 for the oxyalkylenated silicone of EP '661 because US '633 teach these silicones as interchangeable emulsifiers; thus one of skill in the art would be motivated to substitute one for the other because of the expectation of achieving similar surfactant effects. It is known in the art to substitute equivalent surfactants.

The claims are directed to a method of introducing into a composition an emulsion comprising an effective amount of alpha, omega-substituted oxyalkylenated silicone in an effective amount. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches introduction into a composition an emulsion containing the same components as instantly claimed, which would inherently reduce transfer/migration, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Claims 1, 3-19, 23, 25-29, 40, 42-57, 59-60, 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terren et al. (6,159,486).

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Terren et al. teach water-in-oil emulsions, compositions containing the emulsions, and uses thereof. Specifically taught is a cosmetic composition comprising the water-in-oil emulsion, wherein the composition transfers and/or migrates little (see abstract). The emulsion comprises an emulsifying surfactant, wherein the surfactant is an oxyalkylenated silicone of the formula of the instant invention (see Col. 5, line 50-Col. 7, line 13). The surfactant can comprise 5-12% of the emulsion. Cyclohexadimethylsiloxane is taught as an oil that comprises the fatty phase of the emulsion, wherein the fatty phase can also comprise other oils. The aqueous phase comprises 0-14% of a C2-C6 monoalcohol and/or a polyol. The composition can comprise from 0-5% of a co-emulsifier. The emulsion can further comprise pigments, pearlescent agents, and/or fillers. The pigments comprise 0-20% of the composition and can be selected from iron oxide, titanium oxide, and others. The fillers comprise 0-20% of the composition and can be selected from talc, mica, silica, and others. The fillers are preferably spherical and have a size of less than 25 μm . Additives and additional active can be added to the composition in an amount of 0-10%. The emulsions can be in the form of a cosmetic product such as a care product for the body and/or the face and/or scalp, or in the form of a make-up, a foundation, a blusher, an eye shadow, an eye liner, a mascara, or a lip composition. The emulsion can further be in the form of a cream, a milk or a serum. A method of applying the composition to the skin is taught. The reference lacks an exemplification of the instant method and composition, lacks the average molecular weight of R, and viscosity. See Col. 5, line 50-Col. 7, line 12; Col. 7, line 60-Col. 9, line 65; Col. 10, line 39-Col. 11, line 33.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify a method of reducing transfer/migration of composition comprising

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introducing into the composition an emulsion comprising an alpha, omega-substituted oxyalkylenated silicone in an effective amount, because Terren et al. teach a method of reducing transfer/migration of composition comprising introducing into the composition an emulsion and teaches an alpha, omega-substituted oxyalkylenated silicone of the instant method as imparting stability to the emulsion; thus, one of skill in the art would be motivated to exemplify such a method wherein the emulsion comprises alpha, omega-substituted oxyalkylenated silicone because of the expectation of achieving a stable cosmetic product.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify a water-in-oil emulsion comprising a silicone oil, dyestuff, alpha, omega-substituted oxyalkylenated silicone because Terren et al. exemplify a water-in-oil emulsion comprising silicone oil and dyestuff and further teach alpha, omega-substituted oxyalkylenated silicones of the instant method as imparting stability to the emulsion; thus, one of skill in the art would be motivated to exemplify such a composition because of the expectation of achieving a stable water-in-oil emulsion.

While Terren et al. does not provide teachings of the dynamic viscosity of his emulsion, the emulsions of Terren et al. and the instant invention are directed toward the same cosmetic embodiments and the same cosmetic uses. Thus, one would expect similar viscosities. Furthermore, it would have been obvious to teach the composition of Terren et al. as having a dynamic viscosity of 100mPa.s-20Pa.s because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

While Terren et al. does not teach the molecular weight of "R", it must be the same as that recited in the instant invention, because Terren et al. and the instant invention teach the same compound, wherein "R" of the instant invention is "R2" of Terren et al. and "R" and "R2" comprise exactly the same constituents in exactly the same ranges. Thus, the molecular weights must be the same.

Response to Arguments

Applicant argues, "EP '661, however, does not teach or suggest that the silicones disclosed therein could be substituted with any alpha, omega-substituted oxyalkylenated silicones, let alone the specific alpha, omega-substituted oxyalkylenated silicones of claims 1 and 12. In fact, EP '661 teaches away from such a substitution when it states that it is 'very difficult to obtain a highly stable water-in-oil type emulsion cosmetic which comprises a silicone oil as a base". This argument is not persuasive. First, as addressed above, US '633 teaches the interchangeability of the oxyalkylenated silicones of EP '661 with that of the alpha, omega-substituted oxyalkylenated silicones of claims 1 and 12. Second, the Examiner respectfully points out that this argument is not commensurate in scope with the instant claims which do not recite a composition that is based on a silicone oil. Third, the Examiner respectfully points out that EP '615 teaches alpha, omega-substituted oxyalkylenated silicones of claims 1 and 12, as imparting stability to water-in-oil emulsions comprising silicone oils.

Applicant argues, "EP '615 (aka US '633) relates to a 'detergent cosmetic composition'. . . One of ordinary skill in the art would not have been motivated to substitute elements of these compositions, intended for two different and completely incompatible uses". This argument is not persuasive. First, the Examiner respectfully points out that the uses are not completely

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incompatible, as both references are directed to cosmetic compositions that are applied to the skin and/or hair. Second, the Examiner respectfully points out that it is within the skill of the artisan, in the cosmetic art, to substitute one surfactant for another, when the surfactants are taught as interchangeable, even if the cosmetic uses are not exactly the same.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
June 30, 2003



SREENI PADMANABHAN
PRIMARY EXAMINER

6/30/03